

REMARKS

In an Office Action dated August 24, 2005, the claims had been rejected based on Roth. In our Response filed November 23, 2005, a Declaration was submitted wherein the one example in Roth was run to compare Roth's teachings with the present Invention. In an Office Action dated February 1, 2006, the Examiner criticized the Declaration on the basis that Roth teaches a ray curable ink composition comprising a colorant, 10-90% epoxidized soybean oil and a cationic photoinitiator including sulfonium salt. In order to respond to this position, Applicant ran further tests. In these further tests, the amount of initiator and the amount of colorant were maintained constant. To maintain the initiator and colorant constant for all of the tests, it resulted in the material as proposed by the Examiner having 98% epoxidized soybean oil. In the Advisory Action, the Examiner criticized the Declaration on a number of grounds, to include that only one specific amount of epoxidized soybean oil was employed and that it had a very high amount of epoxidized soybean oil. Applicant submits that this criticism is unfairly deserved.

First, in order to provide a true side-by-side comparison, the amount of initiator and colorant were maintained constant so as to provide a comparison between the other additives. Respectfully, it is submitted that this is a true side-by-side comparison for the other additives since the initiator and colorant were maintained constant throughout the examples not only for the data presented in the most recent Declaration but, also, for the data presented in the Declaration of November 2005.

It will be noted that Roth teaches that over 90% of the photopolymerizable monomer can be used, see Column 12, lines 19-20. Thus, it is submitted that the amount of epoxide soybean oil that was used in the most recent Declaration is within the teachings of Roth.

It is also submitted that the Examiner should recognize the fact that this material of Roth that contained the 98% epoxide soybean oil was inoperable. When a reference is inoperable, it does present evidence of the non-obviousness of the invention, see *Railroad Dynamics, Inc. v. A. Stucki Co.* 218 USPQ 618 (E.D. Pa. 1983), *aff'd*, 220 USPQ 929 (Fed. Cir. 1984).

Thus, the fact that Roth's teaching results in an inoperable composition, leads one of skill in the art away from employing the teaching therein. In other words, one of skill in the art would not be tempted to start with an inoperable composition and then add further components thereto with any belief that such a composition would result in a workable composition.

It should be remembered that the tests for obviousness is not "obvious to try" a chemical but, rather, it is whether, given the prior art's teachings, the combined references would, in fact, result in the claimed Invention. Given the fact that Roth's composition results in an inoperable product, it is not obvious that adding oxetane to such a composition would make it operable. For that matter, there is nothing in the secondary reference, Watanabe, that teaches adding oxetane to an inoperable ray curable ink composition would result in an operable ray curable ink composition. Respectfully, the Examiner should consider the fact that Roth produces inoperable results in the evaluation of obviousness.

The second comment that Applicant would like to make in this Submission is the Examiner's statement that the oxetane compound used in the tests for the present Invention in the most recent Declaration was outside the scope of the present

Invention. This is incorrect. Claim 1 recites an oxetane compound. The tests for the present Invention employ an oxetane compound. Thus, the tests with respect to the present Invention were within the scope of the present Invention.

It is true that the oxetane compound used for the tests results was not one of the "preferred" oxetane compounds listed in the Application. The claims, however, as presented herein, are not limited to the preferred oxetane compounds listed in the Application.

Thus, it is respectfully submitted by Applicant that the Examiner reconsider the position taken in the Advisory Action with respect to the data presented in the most current Declaration.

In view of the foregoing, it is respectfully submitted that the Application is in condition for allowance and reconsideration and allowance are respectfully requested.

PTO Form 2038 is enclosed herewith authorizing payment of the appropriate fee for filing of the RCE. Should any further fees or extensions of time be necessary in order to maintain this Application in pending condition, appropriate requests are

hereby made and authorization is given to debit Account # 02-2275.

Respectfully submitted,

LUCAS & MERCANTI, LLP

By: Donald C. Lucas  
Donald C. Lucas, 31,275  
Attorney for Applicant(s)  
475 Park Avenue South, 15<sup>th</sup> Floor  
New York, NY 10016  
Tel. # 212-661-8000

Encl: RCE Transmittal  
PTO Form 2038

DCL/mr